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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/900,332	07/06/2001	Yutaka Yasui	FUJA 18.796	5621
26304	7590	05/03/2006	EXAMINER	
KATTEN MUCHIN ROSENMAN LLP 575 MADISON AVENUE NEW YORK, NY 10022-2585			DANIEL JR, WILLIE J	
			ART UNIT	PAPER NUMBER
			2617	

DATE MAILED: 05/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/900,332

Applicant(s)

YASUI ET AL.

Examiner

Willie J. Daniel, Jr.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This action is in response to applicant's amendment filed on 12 December 2005. **Claims 1-10** are now pending in the present application.

Claim Objections

2. **Claims 2 and 4** are objected to because of the following informalities:
 - a. **Claim 2** recites the limitation "...said determination..." in line(s) 6 of the claim.

There is insufficient antecedent basis for this limitation in the claim and the claim is being considered as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner interprets as "...said determining..." as stated in line(s) 14 of the claim 1. Also, the Examiner requests the applicant to be consistent and use the exact terminology as applicable.
 - b. **Claim 4** recites the limitation "...said determination..." on pg. 4, line 2. There is insufficient antecedent basis for this limitation in the claim and the claim is being considered as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner interprets as "...said determining..." as stated in line(s) 14 of the claim 1. Also, the Examiner requests the applicant to be consistent and use the exact terminology as applicable.

Appropriate correction is required.

3. Regarding applicant's argument on pg. 2, 1st paragraph, "...term *determination* is the proper noun for referring to...*determining means for determining*...", the Examiner

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respectfully disagrees. The Examiner requests applicant to clarify the claim language by properly applying --*determining means for determining*-- in place of the term --*determination*-- to have proper antecedent. Therefore, the objections of claims 2 and 4 are hereby maintained.

4. This list of examples is not intended to be exhaustive. The Examiner respectfully requests the applicant to review all claims and clarify the issues as listed above as well as any other issue(s) that are not listed.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 1-5 and 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Fan et al.** (hereinafter Fan) (**US 6,529,159 B1**) in view of **Tso et al.** (hereinafter Tso) (**US 6,047,327**).

Regarding **claim 1**, Fan discloses a server system for distributing contents to mobile unit (1, 3) which reads on the claimed “portable mobile terminals” in a specific area (see col. 3, lines 17-22; Fig. 1), comprising:

a storage area (63) which reads on the claimed “first database” for storing the contents related to the specific area where the contents distribution service is provided to registered

users of the portable mobile terminals (1) (see col. 4, lines 48-67; col. 5, lines 5-22; col. 3, lines 17-22), where the data is stored for immediate vicinities

a second database (32) for storing contents to be distributed which are prepared by an information provider (e.g., businesses) and a distribution condition thereof which is specified by the information provider for distributing the prepare information (see col. 4, lines 48-67; col. 12, lines 14-42; Figs. 2 and 14), where businesses provide advertising such as coupons to mobile units within the local area which is a geophysical condition;

a third database (33) for storing registered users and a receiving condition of the distributed contents which is specified by the registered users (see col. 3, lines 10-15; col. 5, lines 1-10; col. 6, lines 19-26; col. 8, lines 19-29; col. 9, lines 37-43; col. 11, lines 35-51; col. 12 lines 14-21; Figs. 7 and 14), where the system manages registration information such as type of user (e.g., group) for distributing related information to the group if the group is a taxi or moving company;

data processing station (18) which reads on the claimed “means” for receiving position information from the portable mobile terminals (1) of the registered users (see col. 3, lines 46-63; col. 5, line 66 - col. 6, line 18; Figs. 1-2, 4, and 7);

data processing station (18) which reads on the claimed “determining means” for determining whether the received position information is located in the specified area stored in the first database (63) (see col. 3, lines 13-22, 46-63; Figs. 1-2 and 4);

data processing station (18) which reads on the claimed “content distribution means” for distributing the contents to be distributed satisfying the distribution condition stored in the second database (33) and the receiving condition stored in the third database (33), to the

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corresponding portable mobile terminals (1) of the registered users located in the specified area which is determined by the determining means (18) (see col. 3, lines 17-22; col. 12, lines 14-42; col. 4, lines 55-60; col. 7, lines 13-16; col. 11, lines 13-38; Figs. 1 and 12), where the mobile unit (1) are placed into different groups which have different handling procedures. Fan fails to disclose having the feature automatically distributing. However, the examiner maintains that the feature automatically distributing was well known in the art, as taught by Tso.

In the same field of endeavor, Tso discloses the feature automatically distributing (see col. 2, lines 40-42; col. 20, line 62 - col. 21, line 4; Fig. 1), where the information is automatically sent to the user.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Fan and Tso to have the feature automatically distributing, in order to allow information and content providers to take an active role in the distribution of information, as taught by Tso (see col. 1, lines 53-57).

Regarding **claim 2**, the combination of Fan and Tso discloses every limitation claimed, as applied above (see claim 1), in addition Fan further discloses a server system as described in **claim 1**, further comprising area determining means (18) for illustrating said specific area using a simple figure, and storing said figure in said first database (63) as area information indicated by the latitude and longitude (see col. 5, lines 20-28, 48-55; col. 7, lines 52-56; col. 5 lines 1 - 11; Figs. 2, 7, and 12-13);

wherein said determining means (18) uses the position information received from said portable mobile terminals (1, 3) for said determination (see col. 3, lines 17-22, 46-63; col. 4, lines 48-51; col. 9, lines 31 - 35; col. 12, lines 14-42; Figs. 1-2).

Regarding **claim 3**, the combination of Fan and Tso discloses every limitation claimed, as applied above (see claim 1), in addition Fan further discloses a server system as described in **claim 1**, wherein said position information received from said portable mobile terminals (1, 3) is the latitude/longitude information of said portable mobile terminals (1, 3) (see col. 5, lines 1-10; Figs. 1 and 7).

Regarding **claim 4**, the combination of Fan and Tso discloses every limitation claimed, as applied above (see claim 1), in addition Fan further discloses a server system as described in **claim 3**, further comprising area determining means (18) for illustrating said specific area using a simple figure, and storing said figure in said first database (63) as area information indicated by the latitude and longitude (see col. 5, lines 20-28, 1 - 11; col. 3, lines 17-22, 46-63; col. 4, lines 48-51; col. 9, lines 31 - 35; col. 12, lines 14-42; Figs. 1-2 and 7);

wherein said determining means (18) uses said latitude/longitude information received from said portable mobile information terminals (1, 3) for said determination (see col. 5, lines 20-28, 1 - 11; col. 3, lines 17-22, 46-63; col. 4, lines 48-51; col. 9, lines 31 - 35; col. 12, lines 14-42; Figs. 1-2 and 7).

Regarding **claim 5**, the combination of Fan and Tso discloses every limitation claimed, as applied above (see claim 3), in addition Fan further discloses a server system as described in **claim 3**, wherein said latitude/longitude information is given by the portable

mobile terminals (1, 3) having a GPS receiver (132) (see col. 3, lines 2-7; col. 5, lines 1-11; col. 9, line 61 - col. 10, line 2; Figs. 1, 5, and 7).

Regarding **claim 8**, the combination of Fan and Tso discloses every limitation claimed, as applied above (see claim 1), in addition Fan further discloses a server system as described in **claim 1**, further comprising registration/canceling/change means (18) for executing, by communication with each of said portable mobile terminals (1, 3), the registration/canceling procedure for the user registration of the portable mobile terminal (1, 3) and the registration/change procedure for the receiving conditions of said user stored in the said third database (33) (see col. 12, lines 22-32; col. 3, lines 53-63; col. 9, lines 31-35; col. 5, lines 1-11; Figs. 2, 7, and 14), where the identification number (160) of the mobile unit constitutes the registration of the mobile unit.

Regarding **claim 9**, the combination of Fan and Tso discloses every limitation claimed, as applied above (see claim 1), in addition Fan further discloses a server system as described in **claim 1**, further comprising receiving means (27) for receiving the prepared information and the distribution conditions of the information provider, and for storing the prepared information and the distribution conditions in said second database (32) (see col. 4, lines 48-67; col. 12, lines 22-42; Figs. 1-2 and 14).

Regarding **claim 10**, Fan discloses a server system as described in **claim 1**, further comprising means (18) for receiving the response of a registered user to the distributed contents (see col. 3, lines 17-22; col. 12, lines 14-42; col. 4, lines 55-60; col. 7, lines 13-16; col. 11, lines 13-38; Figs. 1 and 12). Fan fails to disclose having the feature recording and statistically processing said response, and managing and maintaining the result of said

process. However, the examiner maintains that the feature recording and statistically processing said response, and managing and maintaining the result of said process was well known in the art, as taught by Tso.

Tso further discloses the feature recording and statistically processing said response, and managing and maintaining the result of said process (see col. 15, lines 4-18,31-51; col. 4, lines 34-42; col. 6, lines 64-67).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Fan and Tso to have the feature recording and statistically processing said response, and managing and maintaining the result of said process, in order to allow information and content providers to take an active role in the distribution of information, as taught by Tso (see col. 1, lines 53-57).

Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Fan et al.** (hereinafter Fan) (**US 6,529,159 B1**) in view of **Tso et al.** (hereinafter Tso) (**US 6,047,327**) as applied to claim 1 above, and further in view of **Kawamoto (US 6,584,320 B1)**.

Regarding **claim 6**, the combination of Fan and Tso fails to disclose having the feature said position information received from said portable mobile information terminals is the information on the base station of a radio area where each of said portable mobile information terminals is existent. However, the examiner maintains that the feature said position information received from said portable mobile information terminals is the information on the base station of a radio area where each of said portable mobile information terminals is existent was well known in the art, as taught by Kawamoto.

In the same field of endeavor, Kawamoto discloses the feature said position information received from said portable remote terminal (20) which reads on the claimed “portable mobile terminals” is the information on the base station (21) of a cover area which reads on the claimed “radio area” where each of said portable mobile terminals (20) is existent (see col. 5, line 57 - col. 6, line 11; Figs. 5 and 6).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Fan and Tso with Kawamoto to have the feature said position information received from said portable mobile terminals is the information on the base station of a radio area where each of said portable mobile terminals is existent, in order to simply recognize the present position of other user, as taught by Kawamoto (see col. 1, lines 50-51).

Regarding **claim 7**, the combination of Fan and Tso discloses every limitation claimed, as applied above (see claim 6), in addition Fan further discloses a server system as described in **claim 6**, further comprising area determining means (18) for illustrating said specific area using a simple figure, and storing said figure in said first database (63) as area information indicated by the latitude and longitude (see col. 5, lines 20-28, 48-55; col. 7, lines 52-56; col. 5 lines 1 - 11; Figs. 2, 7, and 12-13). The combination of Fan and Tso fails to disclose having the feature wherein said determining means uses, for its determination, the latitude/longitude information converted based on the base station information of the radio area where said portable mobile terminal exists, which station information is received from said portable mobile terminal. However, the examiner maintains that the feature wherein said determining means uses, for its determination, the latitude/longitude information

converted based on the base station information of the radio area where said portable mobile terminal exists, which station information is received from said portable mobile terminal was well known in the art, as taught by Kawamoto.

Kawamoto further discloses the feature wherein said determining means uses, for its determination, the latitude/longitude information converted based on the base station information of the radio area where said portable mobile terminal (20) exists, which station information is received from said portable mobile terminal (20) (see col. 5, line 57 - col. 6, line 11; Figs. 5 and 6).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Fan and Tso with Kawamoto to have the feature wherein said determining means uses, for its determination, the latitude/longitude information converted based on the base station information of the radio area where said portable mobile terminal exists, which station information is received from said portable mobile terminal, in order to simply recognize the present position of other user, as taught by Kawamoto (see col. 1, lines 50-51).

Response to Arguments

6. Applicant's arguments filed 12 December 2005 have been fully considered but they are not persuasive.

The Examiner respectfully disagrees with applicant's arguments as the applied reference(s) provide more than adequate support and to further clarify (see the above claims and comments in this section).

7. Regarding applicant's argument on pg. 2, 1st paragraph, "...term *determination* is the proper noun for referring to...*determining means for determining*...", the Examiner respectfully disagrees. The Examiner requests applicant to clarify the claim language by properly applying --*determining means for determining*-- in place of the term --*determination*-- to have proper antecedent. Therefore, the objection of claims 2 and 4 are hereby maintained.

8. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., ...**independent** of the location (or position information) of a mobile unit...) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Regarding applicant's argument on pg. 4, 2nd paragraph, the applicant's argument relies on a feature(s) not recited in the claim(s).

9. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on

combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Regarding applicant's argument of claim 1 on pg. 4, 2nd paragraph, "...do not disclose distributing information specified by an information provider...", the Examiner respectfully disagrees. The combination of Fan and Tso clearly discloses the feature distributing information specified by an information provider (e.g., businesses) (see col. 4, lines 48-67; col. 12, lines 14-42; Figs. 2 and 14), where businesses provide advertising such as coupons to mobile units within the local area which is a geophysical condition.

10. Regarding applicant's argument of dependent claims 2-10, the claims are rejected for same reasons as set forth above in *items 8 and 9* of this section and as addressed in each corresponding claim.

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Willie J. Daniel, Jr. whose telephone number is (571) 272-7907. The examiner can normally be reached on 8:30-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha D. Banks-Harold can be reached on (571) 272-7905. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

WJD,JR
01 May 2006

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